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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re the Application of:

CROWDER et al.

Serial No.: 09/975,593 ✓

Filed: October 10, 2001

Atty. File No.: 3123-379

For: "SUSPENSION SWAGE PLACE WITH
APPLIED SOLID FILM LUBRICANT
AND METHOD OF ASSEMBLING
THE SAME"

Mail Stop Appeal Brief - Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Dear Sir:

Appellant submits this brief in furtherance of the Notice of Appeal filed simultaneously herewith on January 6, 2004. The fee of \$330.00 set forth in 37 C.F.R. §1.17(c) for filing a brief in support of an appeal is submitted herewith. Please charge any underpayment or credit any overpayment to Deposit Account No. 19-1970.

This Appeal Brief is being transmitted in triplicate pursuant to 37 C.F.R. §1.192(a).

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Examiner:

Kim, P.

APPEAL BRIEF (37 C.F.R. §1.192)

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SHERIDAN ROSS P.C.

BY:

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REAL PARTY IN INTEREST (37 C.F.R. §1.192(c)(1))

The real party in interest in this application is the assignee, Maxtor Corporation. An assignment, whereby the inventors assigned all rights in the above-referenced application to Maxtor Corporation, was recorded in the U.S. Patent and Trademark Office on January 4, 2002 at Reel No. 012427, Frame No. 0757. The terms "Appellant" and "Appellant" in this Appeal Brief mean Maxtor Corporation, unless otherwise indicated.

II. RELATED APPEALS AND INTERFERENCES (37 C.F.R. §1.192(c)(2))

There are no related appeals or interferences.

III. STATUS OF THE CLAIMS (37 C.F.R. §1.192(c)(3))

The status of the claims in this application is as follows:

- A. Total Number of Claims: 31
- B. Status of Claims:
 - 1. Claims canceled: 1-12 and 30.
 - 2. Claims withdrawn from consideration but not canceled: claims 22-29 and 31. In a separate petition under Rule 1.144, Appellant has petitioned for reversal of the Examiner's final restriction requirement with respect to this set of claims.
 - 3. Claims pending: 13-29, and 31.
 - 4. Claims allowed: none.
 - 5. Claims rejected: 13-21.
- C. Claims on Appeal: Claims 13-21, as set forth in Appendix A.

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IV. STATUS OF AMENDMENTS (37 C.F.R. §1.192(c)(4))

An Amendment and Response was filed by a Certificate of Mailing on July 11, 2003 in response to the Office Action having a mailing date of May 28, 2003 (Paper No. 9). In response to this Amendment and Response, a Final Office Action was issued having a mailing date of October 6, 2003 (Paper No. 11). In this Final Office Action, claims 13-21 were rejected under 35 U.S.C. § 103.

V. SUMMARY OF THE INVENTION (37 C.F.R. §1.192(c)(5))

The present invention is directed to a disk drive to include a method of assembling an actuator assembly, and a method of reducing torque out retention values between an actuator arm and a suspension arm. A desired lubricant is applied to metal parts of the actuator assembly which reduces potential contamination during swaging, and also helps to prevent damage to the actuator assembly in the event that the actuator assembly must be disassembled. (Page 4, lines 13-18, page 5, lines 4-9).

The surfaces that are preferably lubricated are those defined as the swage contact surfaces. Lubrication may be applied to an inner face 38 of the opening formed in the actuator arm, the outer surface of the swage boss 48, or both. (Page 10, lines 8-11). Various methods may be used to apply lubrication to include immersing the swage boss, spraying, or vacuum deposition. (Page 9, lines 9-29, page 10, lines 1-7). Coating the swage contact surfaces with a thin film lubricant also enhances the deformation characteristics of the swage boss, facilitates reduction in the retention torque, and provides better consistency in torque out retention values. Each of these attributes contribute in reducing chipping and other potential material failure of the swage contact surfaces. (Page 10, lines 25-29).

VI. ISSUES

The issues on appeal are:

- A. Whether Claims 13-15 and 18-21 should be rejected under 35 U.S.C. §103(a) as being unpatentable over Chung et al. (U.S. Patent No. 5,879,578); and
- B. Whether Claims 16 and 17 should be rejected under 35 U.S.C. §103(a) as being unpatentable over Chung et al. in view of Fisher (U.S. Patent No. 4,215,480).

VII. GROUPING OF CLAIMS

All of the pending claims stand or fall together. Claim 13 is the only independent claim in the appealed claims.

VIII. ARGUMENTS

- A. Claims 13-15 rejected under §103 as being unpatentable over Chung et al.

To establish a prima facie case of obviousness under 35 U.S.C. §103(a), the Examiner must show that: (1) the references teach all of the elements of the claimed invention, (2) the references contain some teaching, suggestion or motivation to combine the references, and (3) the references suggest a reasonable expectation of success. See MPEP §2142. See also In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); In re Kotzab, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000).

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998).

If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In the final Office Action, the Examiner stated that the Chung reference taught each of the limitations in independent claim 13 except for a process of depositing a film lubricant upon at least an outer surface of the swage boss. The Examiner however then concluded that it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify a process of applying a lubricant to the swage ball by placing the lubricated swage ball in the swage boss to lubricate the swage boss for the purpose of reducing the force of friction or wearing either the swage ball or swage boss or both during a production operation. Chung is solely directed to providing a lubricated swage boss for reducing the forces imparted on the actuator which occur during swaging. Chung et al. is absolutely silent as to lubricating any other parts of the actuator assembly.

The presently claimed invention does not claim actual lubrication of the swage ball or the surfaces which come into contact with the swage ball; rather, the claimed invention relates to lubrication of those parts that do not come into contact with the swage ball, and are lubricated for not only the purpose of reducing contamination in a swage operation, but also for reducing torque out retention values in a subsequent de-swaging process. The Examiner's reasoning found in the

final Office Action suggests the Examiner is not clear as to the components recited as being lubricated; the Examiner states that it would have been obvious to lubricate the swage boss by contact with the lubricated swage ball. As claimed in independent claim 13, the surface that is claimed as being lubricated in the present invention is the outer surface of the swage boss that does not make contact with the swage ball. Therefore, the Examiner's reasoning with respect to the Chung reference simply does not describe the correct surface that is claimed as being lubricated in the method of claim 13.

Assuming the Examiner intends for the Chung reference to be applied so that it teaches lubrication of the outer surface of the swage boss, Appellant asserts there is still no teaching, suggestion or motivation within Chung to obviate the claims. Chung is more specifically directed to etching the swage balls to remove aluminum oxide, and then lubricating the swage balls in a lubricating system that is free of aluminum oxide, hard particles and contaminants. Each of the examples provided in Chung are simply descriptions of the manner in which swage balls are prepared by etching, and then lubricated. In order for Chung to be modified to obviate the invention as claimed in independent claim 13, not only does the reference need to contain some teaching, suggestion or motivation to do so, but also the reference must suggest a reasonable expectation of success. Appellant asserts that there is not a single sentence within the Chung reference that remotely implies lubrication of any other parts of the actuator assembly, and further that since there is no such teaching, there can be no reasonable expectation of success found within the Chung reference. If only the swage ball in Chung is lubricated, it is not possible to lubricate the outer surface of the swage boss because the swage ball never contacts the outer surface of the swage boss. Thus inherently, there is no expectation of success.

Since the Examiner has not combined references for the rejection of claims 13-15 and 18-21, Appellant must assume that either the Examiner takes *official notice* or relies on common knowledge for the proposition that the method is obvious for those limitations not expressly found within the Chung reference. (MPEP Section 2144.03). Appellant recognizes that the rationale to modify or combine the prior art does not have to be expressly stated in the prior art; rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine, 837 Fed.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988). In the present case however, the prior art of record does not fairly imply or suggest lubrication of any part or component other than the swage ball. Particularly in disk drives, it is common knowledge that the type and manner in which lubrication is used to assemble or disassemble components may actually contribute to contamination of the disk drive. Thus, for disk drives, simply providing lubrication to any part in the disk drive does not always achieve an advantageous result in terms of reducing contamination. Thus, absent the Chung reference having some teaching of lubricating other parts of the apparatus therein, reliance upon common knowledge or even specific knowledge within the field of disk drives does not result in a fair conclusion that other components should be lubricated.

Claim 14 depends from claim 13 and further includes the step of depositing a film lubricant on the opening in the distal end of the actuator arm prior to the attaching step of claim 13. The Examiner has not addressed the rejection of claim 14 by further reciting where within the Chung reference this feature is disclosed. For the same reasons as set forth above with respect to claim 13, claim 14 is allowable not only as a dependent claim, but also because the

Chung reference simply fails to disclose lubrication of any other parts other than the swage ball itself.

Claims 15 and 18-21 depend directly or indirectly from claim 13 and for the same reason as set forth above, should also be allowed.

Claims 16 and 17 were rejected under Section 103 as being unpatentable over Chung et al. in view of Fisher et al. The Examiner stated that Chung taught all of the limitations except the process of applying the lubricant by spraying or by vacuum deposition, and that Fisher taught a method of making a measuring instrument including a process of applying a lubricant between surfaces by either spraying or vacuum deposition. Claims 16 and 17 depend from claim 13; therefore, for the same reason set forth above, claims 16 and 17 should also be allowed. Furthermore, it is also noted in Fisher that the surfaces that are lubricated to obtain desirable "adhesion" characteristics. ("In order to give good adhesion between the surfaces 25, 26 and the lubricant material, the lubricant material is applied in particulate form, for example, by spraying or vacuum deposition and not by causing a preformed body to adhere to either of the surfaces") (Col. 8, lines 63-67). Clearly in the present invention, the method of applying the lubricant as by spraying or by vacuum deposition has no purpose for enhancing adhesion characteristics.

Filed concurrently herewith is an Amendment After Final that Appellant believes clearly places the claims in better form for consideration on Appeal. In the final Office Action, the Examiner responded to Appellant's prior arguments by stating that the Examiner was unclear as to where the claimed outer surface of the swage boss was located. In the Amendment After Final, Appellant has amended independent claim 13 to further recite that the swage boss has an inner surface that contacts a swage ball during swaging, and an outer surface not contacted by the

swage ball during swaging. This amendment to independent claim 13 should thereby clarify the Examiners concern as to what surface is being claimed as lubricated within claim 13. Attached hereto at Appendix B is a copy of the Amendment After Final.

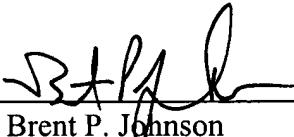
IX. CONCLUSION

For the reasons given above, Appellant respectfully submits that Claims 13-21 are in a condition for allowance, and respectfully requests that the outstanding rejection be reversed.

Respectfully submitted,

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